

REMARKS

This is in response to the Office Action that was mailed on January 12, 2001. Claims 1 and 2 have been amended to be method claims in accordance with the disclosure, the definition of the ring containing the variables G1-G4 has been sharply limited, and formula (I) has been restricted to formula (I'). New claims 17 and 18 are restricted versions of original compound claims 1 and 2, respectively. Compound claims 6-7, 17, and 18 are restricted to the compounds represented by the formula (I'') in view of the descriptions of WO99/06395. No new matter is introduced by this Amendment. Claims 1, 2, 5-9, 11, and 16-18 are in the case.

Claims 1-5, 11-14, and 16 were rejected as allegedly containing improper Markush groups. While Applicants do not believe that the rejection is justified, the main claim herein has been amended to be a method claim, the definition of the ring containing the variables G1-G4 has been sharply limited, and formula (I) has been restricted to formula (I'). Accordingly, withdrawal of this rejection is respectfully solicited.

Claims 1, 2, and 11-14 were rejected under the second paragraph of 35 USC 112.

The Examiner argued that the terminology "cyclic amino group" is unclear, noting the fact that such terminology includes morpholino groups. The terminology in question is well understood by those skilled in the art. Many U.S. patents have been granting reciting that terminology and including morpholino with the definition thereof. As the Examiner will readily appreciate

upon inspection of such patents, morpholino is generally recognized as constituting a cyclic amino group, along with e.g., pyrrolidinyl, piperidinyl, and piperazinyl. Accordingly, the Examiner is respectfully requested to withdraw this aspect of the rejection.

Claim 1 has been amended to delete the superfluous "lower alkoxy".

The "carbonyl" terminology has been corrected to "oxo" terminology. Since compounds having four oxo groups are known, that aspect of the rejection is respectfully traversed.

Claims 12-14 have been deleted, thereby obviating the "substantial duplicates" problem.

It is respectfully submitted that the claims in their present form satisfy the requirements of the statute.

Claims 1-5, 11-14 and 16 were rejected under the first paragraph of 35 USC 112. The Examiner's position appears to be that the terminology "cyclic amino group" renders the claims broader than the supporting enabling disclosure. As noted above, the scope of the terminology in question is clear to those skilled in the art. Furthermore, the compounds represented by the formula (XXX) (see page 86 of the specification) were well known prior to the filing date of this application. Accordingly, it is respectfully urged that the rejection of the claims - in their present form - as exceeding the scope of the enablement should not be sustained.

At the bottom of page 5 of the Office Action, the Examiner cites WO 99/06395 and WO 99/40075.

Regarding WO 99/06395, the compounds represented by formula (I) therein overlap with the compounds represented by formula (I') herein. WO 99/06395 describes oxido squalene-cyclase inhibiting activity, but is silent as to the FXa inhibiting activity of the present invention (methods). The compounds of claims 17 and 18 herein are restricted to formula (I''), which is defined to avoid overlap with WO 99/06395. Claims 8 and 9 herein, however, recite concrete compounds having FXa inhibiting activity. These compounds may be generically included within formula (I) of WO 99/06395, but they are not specifically described therein.

The compounds of WO 99/40075 (see also EP 1.054,005) overlap the compounds of formula (I') herein (as well as the compounds of WO 99/06395) when the ring A having an oxo group is piperazine, X' is methylene, Y is piperidine, X is a bond, and Z is a nitrogen-containing heterocyclic group represented by (3) in WO 99/40075. When the ring A has further substituents, the compounds overlap with those herein (but not with WO 99/06395). The pharmaceutical activity of WO 99/40075 is, like the present application, FXa inhibiting activity. WO 99/40075 claims priority to JP24833/98 (Feb. 5, 1998) and JP317205/98 (Nov. 9, 1998). The present application, on the other hand, claims priority to JP367583/97 (Dec. 26, 1997) and JP311491/98 (Oct. 30, 1998). The newly amended claims of the present application are entitled to

priority dates earlier than the relevant effective dates of WO 99/40075 (and EP 1,054,005).

Conclusion

It is believed that a full and complete response has been made to the Office Action. Accordingly, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Mr. Richard J. Gallagher, Registration No. 28,781 at (703) 205-8008.

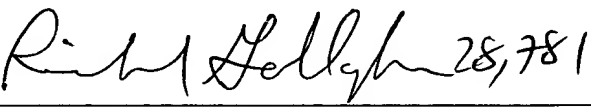
Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application and the required fee of \$890.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: Marked Up Version of Claims Showing Amendments